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07/11/91	10/21/87	KING	FIRST NAMED INVENTOR	C	50227	ATTORNEY DOCKET NO.
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MARSCHER, A
EXAMINER

187 UNIT	PAPER NUMBER
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07/01/91

DATE MAILED:

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

☒ This application has been examined ☒ Responsive to communication filed on 3/19/91 ☐ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), ~~one~~ from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- | | |
|---|---|
| 1. <input type="checkbox"/> Notice of References Cited by Examiner, PTO-892. | 2. <input type="checkbox"/> Notice re Patent Drawing, PTO-948. |
| 3. <input checked="" type="checkbox"/> Notice of Art Cited by Applicant, PTO-1449. | 4. <input type="checkbox"/> Notice of Informal Patent Application, Form PTO-152 |
| 5. <input type="checkbox"/> Information on How to Effect Drawing Changes, PTO-1474. | 6. <input type="checkbox"/> |

Part II SUMMARY OF ACTION

1. ☒ Claims 12-14, 16-30, and 33 are pending in the application.
Of the above, claims _____ are withdrawn from consideration.
2. ☒ Claims 15, 31, and 32 have been cancelled.
3. ☐ Claims _____ are allowed.
4. ☒ Claims 12-14, 16-30, and 33 are rejected.
5. ☐ Claims _____ are objected to.
6. ☐ Claims _____ are subject to restriction or election requirement.
7. ☒ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.
8. ☐ Formal drawings are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable; ☐ not acceptable (see explanation or Notice re Patent Drawing, PTO-948).
10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on _____, has (have) been ☐ approved by the examiner; ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction, filed _____, has been ☐ approved; ☐ disapproved (see explanation).
12. ☐ Acknowledgement is made of the claim for priority under U.S.C. 119. The certified copy has ☐ been received ☐ not been received ☐ been filed in parent application, serial no. _____; filed on _____.
13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14. ☐ Other

EXAMINER'S ACTION

Applicant's arguments filed 3/19/91 have been fully considered but they are not deemed to be persuasive. Rejections and/or objections not reiterated from previous office actions are hereby withdrawn. The following rejections and/or objections are either newly applied or reiterated. They constitute the complete set presently being applied to the instant application.

The following is a quotation of the first paragraph of 35 U.S.C. § 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The specification is objected to under 35 U.S.C. § 112, first paragraph, as failing to adequately teach how to make and/or use the invention, i.e. failing to provide an enabling disclosure.

The lack of enablement due to undue experimentation for the choice of probes having the desired specificity is maintained as a basis for this rejection as previously applied.

Claims 12-14 are rejected under 35 U.S.C. § 112, first paragraph, for the reasons set forth in the objection to the specification.

Claims 12-14, 16-30, and 33 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 12 cites the phrase "15 contiguous nucleotides of or at least 30 contiguous nucleotides with at least 60% homology of". This phrase is unclear and confusing. Is the probe 15 basepairs long or 30 or what? Also what is meant by the phrase "homologous of". This wording is awkward and unclear.

Claims 16-30, and 33 cite compositions which are nucleic acid sequences. Such a sequence is simply a series of letters which is a mathematical construct and not clearly a composition. Clarification of what is being claimed in these claims is requested.

Line 12 of claim 16 cites the word "complimentary" which appears to be misspelled thus making claim 16 vague and indefinite.

35 U.S.C. § 101 reads as follows:

"Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title".

Claims 12-14, 16-30, and 33 are rejected under 35 U.S.C. § 101 because they disclosed utility is not shown in the instant specification as previously stated. Applicants argue that the Southern blot of Figure 8 shows the stated utility. This showing of utility is only for the entire gene used as a probe not small 15 basepair portions which are apparently being claimed.

Papers related to this application may be submitted to Group 180 by facsimile transmission. Papers should be faxed to Group 180 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989).

Serial No. 07/110,791

- 4 -

Art Unit: 187

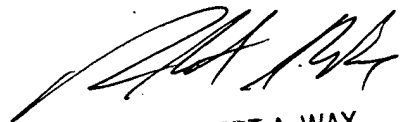
The CM1 Fax Center number is (703) 308-4227.

Any inquiry concerning this communication should be directed to Ardin Marschel, Ph.D., at telephone number: (703) 308-0196.

AM

A. MARSCHEL:am

May 31, 1991



ROBERT A. WAX
SUPERVISORY PATENT EXAMINER
ART UNIT 187